

Appl. No. : 10/829,135
Filed : April 21, 2004

REMARKS

This is in response to the Office Action mailed February 23, 2007. Claims 1, 4 and 10-19 are pending.

By the Office Action, the Examiner indicated the rejection of Claims 1 and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over FDP Magnetics in view of Fontana (USPN 4625508), and rejected Claims 4 and 12-19 as unpatentable over FDP Magnetics in view of Fontana or Kundert (USPN 2775093).

Rejections Over FDP Magnetics

As the Examiner indicates, the FDP Magnetics reference does not disclose the: (1) the claimed links of titanium; (2) the claimed relative size of the face of the magnet compared to the face of the whole link as claimed; or (3) the claimed oval-shaped magnetic elements. The Examiner indicates that it would be obvious to modify FDP Magnetics to address these deficiencies.

Applicant previously presented evidence of non-obviousness as to the invention as claimed. In particular, Applicant has submitted evidence that it is not obvious to: (1) utilize a solid titanium or precious metal link; (2) to simply increase "magnet size" and/or (3) use an oval magnetic element (including use of such in particular orientations relative to link configurations).

Applicant notes that the Examiner has asserted, by bald assertion without any supporting evidence, the obviousness of various of the claimed features and thus the obviousness of the asserted combination. On the other hand, Applicant has submitted evidence of non-obviousness. As noted by the Federal Circuit, "[o]bjective evidence [of non-obviousness], composed of real world facts, is entitled to great weight in a case." Rosemount, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540,

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221 U.S.P.Q. 1 (Fed. Cir. 1984). Such evidence "may often establish that an invention appearing to have been obvious in light of the prior art is not." Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 24 U.S.P.Q. 1321 (Fed. Cir. 1992).

a. Claimed Surface Area Relationship

As noted, independent Claims 1 and 10 recite links having associated magnetic elements, where a face of the magnetic element comprises at least 50% of the total area comprising a rear of the link. As suggested by the Examiner, it would be obvious to increase the size of a magnet associated with a link, thus causing the magnet's surface area to increase. Applicant previously submitted direct evidence that it would not be obvious to increase the size of a magnet associated with a link in a manner which would achieve such a ratio. Referring to the Declaration of Jeffrey Dunmire (previously submitted on February 3, 2006), the known configuration for magnetic jewelry is a link having a cylindrical magnet. As indicated in the Declaration, in accordance with the only known configuration, corresponding increases in the size of the magnet require corresponding increases in the size of the associated link, such that the resultant surface area ratio between the link and the magnet does not increase. See Declaration of Jeffrey Dunmire at ¶¶ 5 and 11-16.

b. Claimed Oval Magnet Shape

Relative to the oval shape of the magnetic element, as recited in Claims 4, 12 and 15, the Examiner asserts that it would be obvious to change the shape of the links to improve or change the aesthetic appearance of the bracelet or optimize the surface area contact.

First, the Examiner asserts that it would be obvious to change the shape of FDP's magnet to an oval shape in order to change the aesthetics of the bracelet. Applicant notes, however, that a

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change in the shape of the magnet does not change the aesthetics of the bracelet, and there would thus be no motivation to make the asserted change in magnet shape. In particular, assuming the shape of the link remains the same, a change in the shape of the magnet does not change the aesthetic appearance of the link, since the magnet is not generally visible, being located at the rear of the link. Second, the aesthetic appearance of the links themselves need not change even if the magnet shape changes (because the shape of the magnet can change without changing the link with which it is associated) such that, once again, the change in shape of the magnet does not relate to any change in aesthetic appearance of the link and thus provides no motivation for such a change. Moreover, Applicant notes that Claims 4, 12 and 15 do not claim magnetic elements having the same shape as the corresponding link. In the preferred embodiment of the invention, oval magnets are utilized with rectangular links (i.e. the link shape and magnet shape are not the same, such that there is clearly no motivation for changing magnet shape, since the link shape is clearly independent thereof).

As part of this basis of rejection, the Examiner cites Kundert, indicating that "Kundert is applied to show that the aesthetics of the links can be changed from one shape to another" and that "Kundert is only used to show that a change in shape of a link in a linked bracelet is old and well known". Applicant notes that, even if true, these fact have nothing to do with the claimed shape of the magnet. In particular, Kundert discloses having link-shaped parts (1c) and cup-shaped parts (2c) of the same shape. Kundert, however, does not disclose or suggest providing magnetic jewelry having magnets of a particular shape (and less yet, magnets of an oval shape associated with non-oval links).

Second, the Examiner asserts it would be obvious to optimize the surface area of the magnet face on the link (for health benefits) and that it would be obvious to do so by using a circular or

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square shaped magnet with a square link, and an oval or rectangular shaped magnet if the link is rectangular. For this additional reason, the Examiner asserts that it would be obvious to utilize an oval magnet as claimed.

Applicant asserts that the Examiner's assertion is based upon hindsight. First, the Examiner has not cited any prior art showing magnetic jewelry having a link with an associated magnet having a shape other than circular/cylindrical, regardless of the shape of the link. Second, there are potentially an unlimited number of different link shapes and magnet shapes that might be utilized. However, Applicant claims the specific relationship of an oval magnet.

In addition, Applicant has provided actual evidence of the non-obviousness of the claimed combination. In the recent case of KSR Int'l v. Teleflex, Inc., 550 U.S. ___, (2007), the Supreme Court affirmed various principles regarding obviousness determinations. Among them, the Court affirmed that secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc. are relevant to the determination of obviousness. The Court also affirmed that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious (citing U.S. v. Adams, 383 S.Ct. 39, 40 (1966)).

In this case, Applicant has provided detailed evidence that the prior art teaches away from the claimed configuration. See Declaration of Jeffrey Dunmire at ¶¶ 5-7 and 17. In particular, though magnetic jewelry has been produced for years, such jewelry is limited in configuration to links having circular/cylindrical magnets. Moreover, Applicant has provided evidence of various secondary considerations, including "long-felt need" and "failure of others", which evidence and factors support a finding of non-obviousness. See Declaration Jeffrey Dunmire at ¶¶ 11-16. Among

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this evidence is the fact that until the time of Applicant's invention, there was no known method suitable for associating magnets of shapes other than circular/cylindrical with a jewelry link. As indicated:

This oval magnet configuration is also non-obvious because it overcomes the complex manufacturing issue detailed above and when considering various other issues which make the oval configuration an unlikely candidate. At first blush, only expensive and time consuming manufacturing techniques such as molding, laser-etching, or the link appear suitable for forming holes in the links which are other than circular in shape. In addition, use of anything but a simple circular punch at the center of the link risks that the recess (and mating magnet) will not be centered and aligned with the link, causing the associated magnet to be visually askew when associated with the link. After considerable effort, I determined that an oval recess could be formed by carefully inter-relating multiple individual punches with each punch progressively deepening the recess to ultimately result in an acceptable receptacle to place the magnet. This multi-punch process utilizes a simple single circular punch, but permits the much more complex oval shaped recess to be created. Further, because of the multi-step process starting with a central punch, the location of the recess can be controlled very accurately to ensure that it (and the magnet placed in the recess) is aligned with the link. Additionally, this multiple punch procedure overcomes the inherent stress cracking problem of the link during the punching process and permits use of oval magnets which also have a minimal stress point configuration. In this manner, I solved both the problem of how to easily manufacture the jewelry, but also facilitated use of magnets with large surface areas relative to the links with which they were to be used.

See Declaration of Jeffrey Dunmire at ¶ 16.

This evidence also establishes the non-obviousness of this claimed feature.

c. Other Issues

Relative to Claims 1, 10 and 15, Applicant also notes that, at most, the FDP Magnetics reference discloses plated magnetic jewelry. Claims 1, 10 and 15 both recite links constructed from solid titanium or precious metal. As indicated in the prior-submitted Declaration of Jeffrey Dunmire, this configuration overcomes problems associated with link plating, such as wearing and scaling

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which ultimately result in exposure of the base metal and resulting issues of skin discoloration and the like associated with steel and similar base metals. Applicant asserts that the prior art does not disclose this claim feature and that the submitted evidence establishes the non-obviousness of this claim element.

Relative to Claim 16, Applicant asserts that no prior art discloses or suggests the limitation claimed therein of links having a notch at a first end and an outwardly extending tongue at an opposing second end and wherein the magnetic element is offset in a lengthwise direction along the link by a distance which the notch extends into the first end.

Additional evidence of the non-obviousness of the claimed invention is that competitors, who would be viewed as "having ordinary skill in the art" have not created products having the features as claimed. For example, despite the fact that plated magnetic jewelry suffers from the above-mentioned problems, Applicant is unaware of any competitors who have solved those problems by utilizing solid precious metal links.

Similarly, despite the fact the beneficial health affects of larger magnets is known, those of ordinary skill in the art have never derived Applicant's claimed configuration (relative to magnet to link surface area relationship or oval magnets).

For example, at the website <http://www.magnetemporium.com/magnetichealing.htm>, it is noted that:

Magnet size is also therapeutically important. For example, small neodymium magnets may have strength in excess of 10,000 gauss. However, because their fields can only penetrate a few inches into the body, they are used for treating localized conditions. In contrast, a large block magnet of much lower flux strength may penetrate through the body. Given the importance of size, the profound influence Earth's small 0.5-gauss field has on life is more readily understandable.

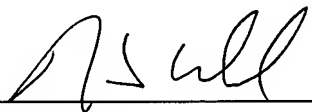
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Thus, while those in the industry appreciate the benefits of a larger magnet, the claimed configuration is clearly not merely a matter of design choice and thus clearly non-obvious, since competitors have never conceived of Applicant's claimed configuration.

Summary

Applicant asserts that Claims 1, 4 and 10-19 are in a condition for allowance. If any matters remain outstanding, the Examiner is invited to contact the undersigned by telephone.

Respectfully submitted,

Dated: July 23, 2007 By: 

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